

**REMARKS**

Upon entry of this amendment, Claims 1-122, 126-139 and 141-169 will be pending. Claims 1 and 121 have been amended. Claims 123-125 and 140 have been cancelled. Claims 165-169 are new and are supported in the specification by Example 2 on pages 23 and 24.

**35 U.S.C. §102(b) Rejection**

Reconsideration is requested of the rejection of Claims 1-2, 4-10, 12-18, 20-22, 24-26, 28-30, 32-34, 36-38, 40-42, 44-46, 48-50, 52-54, 56-58, 60-62, 64-66, 68-70, 72-74, 76-78, 80-82, and 84-86 as being anticipated by compound 7 in Greenwald et al., US Pat. No. 5,614,549. Amended claim 1 and claim 92 require X<sub>3</sub> (the C3' substituent) to be substituted or unsubstituted alkyl, alkenyl, alkynyl or heterocyclo. In contrast, Greenwald's compound 7 requires a phenyl substituent at C3'. Accordingly, claims 1 and 92, and the claims that depend therefrom, are not anticipated by Greenwald.

**35 U.S.C. §103(a) Rejection**

Reconsideration is requested of the rejection of Claims 1-164 under 35 U.S.C. §103(a) as being unpatentable over Chen et al. (Bioorg. & Med. Chem. Letters, 1994, 4(18), pp. 2223-2228) and Greenwald et al. (J. Org. Chem. 1995, 60(2), pp. 331-336) in view of Swindell et al. (U.S. Patent No. 5,939,566). Greenwald et al., Chen et al., and Swindell et al. do not individually or collectively disclose or suggest the claimed compounds.

Greenwald et al. disclose certain C7 substituted taxanes which are said to have improved watersolubility. Furthermore, Greenwald et al.'s taxanes possess a phenyl group at the C3' position and an acetoxy group at the C10 position. In contrast, amended claim 1 and claim 92, require X<sub>3</sub> (the C3' substituent) to be substituted or unsubstituted alkyl, alkenyl, alkynyl or heterocyclo and requires the C10 substituent to be hydroxy.

Chen et al. disclose certain C7 substituted taxanes. Furthermore, Chen et al.'s taxanes possess a phenyl group at the C3' position and an acetoxyl group at the C10 position. In contrast, amended claim 1 and claim 92 require X<sub>3</sub> (the C-3' substituent) to be substituted or unsubstituted alkyl, alkenyl, alkynyl or heterocyclo and require the C10 substituent to be hydroxy.

Swindell et al. would not have led a person of ordinary skill to modify the compounds disclosed in Greenwald et al. or Chen et al. to arrive at the compounds of amended claim 1 and claim 92. Swindell et al. merely disclose a synthetic scheme for the preparation of a family of taxanes. Significantly, Swindell et al. do not suggest that any compound which may be made by their process possesses properties which are superior in any respect to the properties of any other compound which may be made by their process; nor do they present any data from which such a conclusion may be deduced. They merely state that their process may be used to prepare a variety of compounds, including those which are substituted at C1, C2, C7, C9, C10, C3' and at nitrogen on the C13 side chain with a wide variety of substituents.

Based upon the combined disclosures by Greenwald et al., Chen et al., and Swindell et al., a person of ordinary skill would not have had any basis to arrive at the invention defined by amended claim 1 and claim 92. Swindell, et al. does not provide any data showing superiority of any of the derivatives made by the process disclosed. Thus, a person of ordinary skill would not have had any reason, based upon Swindell et al.'s disclosure, to substitute any group disclosed by Swindell et al. for any group possessed by compounds disclosed in Chen et al. or Greenwald et al. Furthermore, Swindell et al. disclose a variety of alternative substituents at C-1, C-2, C-7, C-9, C-10, C-3' and at nitrogen on the C-13 side chain and Swindell et al. fail to provide a person of ordinary skill with any reason to select any of these alternative substituents over any other alternative substituent.

With all due respect, the Office's rejection of claims 1 and 92 appears to be nothing more than a hindsight reconstruction of the claimed invention. The Office has not, and

indeed, based upon this record cannot identify any motivation to select the specific combination of substituents recited in claims 1 and 92 based upon the combined disclosures of Greenwald et al., Chen et al., and Swindell et al.

Each of claims 2-91, 93-122, 126-139 and 141-169 depend from claims 1 and 92 and thus, are patentably distinct from the combined disclosures of Greenwald et al., Chen et al., and Swindell et al. for the same reasons as those stated with respect to claims 1 and 92. In addition, they are independently patentable by reason of the additional requirements which they introduce beyond those specified by claims 1 and 92. It is noted that the Office has not attempted to articulate a *prima facie* case of obviousness with respect to any of these claims, in particular.


**CONCLUSION**

Applicant submits that the present application is now in a condition for allowance and requests allowance of the pending claims.

Applicant requests a one (1) month extension of time to and including July 17, 2003 for filing a response to the above-mentioned Office action. A check for \$128 for the added claims and payment of the applicable extension fee is enclosed.

The Commissioner is hereby authorized to charge any underpayment and credit any overpayment of government fees to Deposit Account No. 19-1345.

Respectfully submitted,



---

Kathleen M. Petrillo, Reg. No. 35,076  
SENNIGER, POWERS, LEAVITT & ROEDEL  
One Metropolitan Square, 16th Floor  
St. Louis, Missouri 63102  
(314) 231-5400

JSH/dfw  
Express Mail No. EV 327056695 US